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IN21/1028

EXAMINER

BECKER, D

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 10/28/98

Please find below and/or attached an Office communication concerning this application or
proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/000 366

Applicant(s)

Hoashi et al

Examiner

Drew Becker

Group Art Unit

1761

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Pri d for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on 9-24-98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-9 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) /
- ☒ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "almost uniformly milling" in claims 1-3 and 7 is a relative term which renders the claims indefinite. The term "almost uniformly milling" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unknown as to whether the above phrase refers to size or shape and to what degree.

4. Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is improper for "method of using" claims to be dependent on "method of making" claims, as claims 8-9 use the fish paste product made in claim 7.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al in view of JP 60-70049.

Katoh et al teach the concepts of crushing and thawing frozen fish meats as a preliminary step (column 3, lines 31-37), milling into pieces of between 3.0 and 10 mm in size (column 7, line 4), and mixing in additives with a mixer of the same type as that of the applicants' (column 7, line 10; Figure 1). Katoh et al do not teach the concept of first freezing followed by grinding of the fish meats and the grinding step comprising crushing followed by milling of the fish meats. JP 60-70049 teaches the concept of grinding already frozen fish meats into particles (claim) by use of a cutter (page 3, lines 24-30). It would have been obvious to one of ordinary skill in the art to incorporate the freezing then milling method of JP 60-70049 into the method of Katoh et al since Katoh et al already include the steps of crushing and freezing but not explicitly in the order of JP 60-70049 and thawing after size reduction takes less time because the decreased thickness of the fish aids conductive heat transfer. It would have been obvious to one of ordinary skill in the art to combine the cutter of JP 60-70049 with the uniform milling of Katoh et al since a more

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gradual size reduction process by use of a cutter, as disclosed by the applicants (page 5, line 20), would be beneficial to the service life of the milling machinery.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al and JP 60-70049 in view of JP 61-33739.


Katoh et al and JP 60-70049 teach the concepts mentioned above. Katoh et al also teach the concepts of producing kamaboko by molding the ground fish (column 6, line 52), heating the ground fish while in the mold for network formation (column 6, line 60), and further heating (column 6, line 62). Katoh et al and JP 60-70049 do not teach the concept of heating the fish paste by passing electric current through the fish. JP 61-33739 teaches the concept of heating fish by passing electric current through it (Constitution). It would have been obvious to one of ordinary skill in the art to incorporate the electric heating of JP 61-33739 into the method of Katoh et al and JP 60-70049 since ohmic heating is a commonly known method of heating and does not require a heating medium, such as oil or steam, to contact the food.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew Becker whose telephone number is (703) 305-0300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The fax phone number for this Group is (703)-305-3601 .

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


David Lacey
Supervisory Patent Examiner
Technology Center 1700

Drew Becker

October 22, 1998

10/22/98